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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,378

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Declan Patrick Kelly

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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EXAMINER

KIM, EDWARD J

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,378	<b>Applicant(s)</b> KELLY ET AL.	
	<b>Examiner</b> EDWARD J. KIM	<b>Art Unit</b> 2455	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 9-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. This office action is in response to the Request for Continued Examination (RCE) filed on 01/30/2009.
2. Claims 1-2 and 6-8 are pending in this office action. Claims 3-5 and 9-10 have been cancelled by the Applicant.

### ***Response to Amendment***

3. The Examiner withdraws the previous 112 first and second paragraph rejections, as now the claims do not recite the terms “normal playing status” nor “abnormal playing status”.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 2, 6-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 6 now recite the term “playing out essential content” and “not be playing out essential content”. These terms are not defined in detail in the Specification to allow one of ordinary skill in the art to make and/or use the invention. Especially the term “essential content” is not defined in detail.

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Claims 2, 7, and 8 are rejected under the same basis.

It is disclosed in the Specification:

“the network management apparatus is used to download the information required in the normal playing status according to the searched URL corresponding to the information which is not downloaded while the player is in the abnormal playing status.

The optical disc playing method described by present invention is to first detect the playing status, search the URL corresponding to the information which is not downloaded if the detected playing status is abnormal, and then download the information required in the normal playing status while the player is in the abnormal playing status.

Since the information required in the normal playing status can be downloaded in advance while the player is in the abnormal playing status such as pause status, copyright information status or director annotation status, the phenomena such as playing is not smoothly, even playing is interrupted and so on can be avoided during the process of playing while downloading.” (pg.3 ln.8-21 of the Specification filed on 07/03/2008)

Furthermore:

“ The content stored in a optical disc comprises the essential content users want to view, the URLs (Uniform Resource Locator) list corresponding to the information required to be downloaded, and other accessory information. The so-called other accessory information refers to the copyright information and the director annotation, and the like.

The optical disc playing process includes a normal playing status (the status that the essential content of a optical disc is being played normally) and an abnormal playing status. The abnormal playing status includes pause status, copyright information status (some text information used by copyright warning) and director annotation (some explanatory words used by director annotation), and the like. The player can play while downloading information while it is in the normal playing status, wherein the information required to be downloaded can be used directly without downloading if it has been stored temporarily in the storage of the player.

The optical disc player provided by present invention can play while downloading information while it is in the normal playing status; and can download in advance the information required to be downloaded in the normal playing status while it is in the abnormal playing status besides the normal playing status. The information required to be downloaded in the normal playing status is downloaded in advance while the player is in the abnormal playing status, and the downloaded information is stored in the player in order to be used directly without being downloaded while the player is in the normal playing status, thereby avoiding the phenomena that the playing is not smooth, even the playing is interrupted caused by playing while downloading.” (pg.4 ln.15 – pg.5 ln.19 of the Specification filed on 07/03/2008)

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The Specification suggests that “essential content” is what “users want to view”, wherein the normal play of the essential content is considered to be “normal playing status”.

“Abnormal playing status” is defined as including pause status, copyright information status (some text information used by copyright warning) and director annotation (some explanatory words used by director annotation), and the like.

Unlike the Applicant’s assertion that the Applicants have “sufficiently described these terms such that its meanings would be readily appreciated by a person of ordinary skill in the art.” (pg.10 last line of the Specification filed on 07/03/2008), one of ordinary skill in the art will not be able to fully comprehend the distinction between an “essential content” and what is not considered a “essential content”.

It is disclosed that the optical disc contains URLs list corresponding to information required to be downloaded, and other accessory information includes copyright information and director annotations, and the like (see above citation from the Specification).

As disclosed by the Applicant, in general, optical discs contain various contents that users want to view. For example, optical discs, such as a CD or a DVD, may include a movie and bonus features (additional scenes, links to related information, etc.). When the optical disc is inserted, the user may have an option of playing the movie or access bonus features. When the movie play is selected, the movie typically comprises of title, copyright information (Warning of making a copy), previews of other movies, the movie itself, and the credits.

It is hard to distinguish what is considered to be the content “users want to view”, hence, the term “essential content” cannot be fully understood. Users may want to view the bonus features, director annotations, etc. The content referred to via the URLs list is required to be downloaded for the user to view data the user desires, however, it is considered to be not an “essential content” but “accessory information”.

As the definition of the term “abnormal playing status” and “accessory information” includes an open-end statement, “and the like”, one of ordinary skill in the art would not be able to fully understand the distinction between an “essential content” or a non-essential content.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1 and 6 now recite the term “playing out essential content” and “not be playing out essential content”. These terms are not defined in detail in the Specification to allow one of ordinary skill in the art to comprehend the invention. Especially the term “essential content” is not defined in detail. Refer to 112 first paragraph rejection above.

Claims 2, 7, and 8 are rejected under the same basis.

Claims 2 and 8 recites, “act of storing the downloaded information for subsequent access and use when the playing out of essential content is subsequently detected”. It is unclear to what exactly the claimed subject matter is, since the downloaded information is “required for playing out of essential content” according to claim 6, and claim 8 claims that the downloaded information is stored when the playing is detected. The downloaded information must be downloaded, hence stored, prior to playing the content, since the information is required for playing. The Applicant has failed to particularly point out and distinctly claim the subject matter which is considered as the invention.

Claims 1 and 6 now recite, “accessing one or more URLs identified by the search module to download information that is required for playing out essential content only while the player is detected to not be playing out essential content”. This is no different from the conventional download-then-play method. For example, in a non-streaming download of media content, the media, such as a movie file (which is required for playing out the content), is downloaded, and after the movie is downloaded, the user is able to play the media. The essential content/movie file is downloaded only when the player is not playing the content. The Applicant has failed to particularly point out and distinctly claim the subject matter which is considered as the invention.

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***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 2, 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kanazawa et al. (US Patent #6,580,870 B1), hereinafter referred to as Kanazawa.

Kanazawa discloses a system for reproducing AV information from a recording medium, which utilizes other external resources on a computer network that is referenced via URL (Kanazawa, Abstract).

Regarding claim 1, Kanazawa discloses, an optical disc player (Kanazawa, Abstract, col.1 ln.20-25, col.1 ln.57-67), comprising: a detecting module for detecting whether the player is playing out essential content or whether playing out of essential content is currently interrupted, and sending a searching command when the playing out of essential content is detected to be currently interrupted (Kanazawa, col.5 ln.10-34, col.6 ln.54-60, col.8 ln.10-20);

a searching module for searching a URL list stored on an optical disc in response to the search command to identify a URL in the URL list which provides a link to information which is required for playing out of essential content of the optical disc, but which has not yet been downloaded; and (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65. Kanazawa discloses the use of external resources on a computer network.);

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and a network management apparatus for accessing one or more URLs identified by the search module to download information that is required for playing out essential content only while the player is detected to be in the abnormal playing status (Kanazawa, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54.).

Regarding claim 2, Kanazawa disclosed the limitations, as described in claim 1, and further discloses, a storage for storing the downloaded information to be subsequently accessed and used when the playing out of essential content is subsequently detected (Kanazawa, col.5 ln.10-34, col.6 ln.43-50. Kanazawa discloses downloading external information from web pages or on a computer network it is connected to.).

Regarding claim 6, Kanazawa discloses, a playing method of optical disc, comprising acts of: detecting whether playing out of essential content is currently occurring or whether playing out of essential content is currently interrupted (Kanazawa, col.8 ln.10-20);

searching a URL list stored on an optical disc in response to the search command to identify a URL in the URL list which provides a link to information which is required to be downloaded for the playing out of essential content of the optical disc, but which has not yet been downloaded, if the playing out of essential content is detected to be currently interrupted (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.

Kanazawa discloses the use of external resources on a computer network.);

and accessing one or more URLs identified by the searching to download the information that is required for the playing out of essential content, wherein the accessing occurs only while the player is detected to not currently playing out essential content (Kanazawa, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65, col.6 ln.43-50. Kanazawa



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discloses downloading external information from web pages or on a computer network it is connected to.).

Regarding claim 7, Kanazawa disclosed the limitations, as described in claim 6, and further discloses, wherein the act of searching includes waiting until the playing out of essential content is interrupted prior to searching the URL of the information which is not yet downloaded (Kanazawa, col.5 ln.46-54, col.6 ln.43-50, col.2 ln.20-25, col.5 ln.18-34, col.6 ln.55-67, col.5 ln.46-54, col.12 ln.55-65.).

Regarding claim 8, Kanazawa disclosed the limitations, as described in claim 6, and further discloses, further comprising the act of storing the downloaded information for subsequent access and use when the playing out of essential content is subsequently detected (Kanazawa, col.5 ln.10-34, col.6 ln.43-50.).

### ***Response to Arguments***

10. Applicant's arguments filed on 01/30/2009 have been fully considered but they are not persuasive.

The Applicant argues that Kanazawa fails to disclose,

“a detecting module for detecting whether the player is playing out essential content or whether playing out of essential content is currently interrupted, and sending a searching command when the playing out of essential content is detected to be currently interrupted”. (refer to pg.14, pg.15, pg.16, etc. of the Amendment filed on 01/30/2009)  
In response to the argument, as acknowledged by the Applicant, Kanazawa discloses

“that after reproduction of title information is suspended, the Web server is accessed to access network resources. When access of the network resource is completed, reproduction of the title information is resumed” (refer to second paragraph of pg.15 – first paragraph of pg.16, third

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paragraph of pg.16, of the Amendment filed on 01/30/2009). The system acknowledges the suspension of title information, which in other word means that the system detects the suspension of the title information, hence, the system detects that playing of the essential content is interrupted. At least for this reason and the 35 USC 112 rejections, Kanazawa discloses every feature that is claimed by the Applicant.

In response to the argument regarding:

“accessing one or more URLs identified by the search module to download information that is required for playing out essential content only while the player is detected to not be playing out essential content” (refer to pg.17 of the Amendment filed on 01/30/2009)

This is no different from the conventional download-then-play method. For example, in a non-streaming download of media content, the media, such as a movie file (which is required for playing out the content), is downloaded, and after the movie is downloaded, the user is able to play the media. The essential content/movie file is downloaded only when the player is not playing the content. The Applicant has failed to particularly point out and distinctly claim the subject matter which is considered as the invention. Furthermore, Kanazawa discloses “that after reproduction of title information is suspended, the Web server is accessed to access network resources. When access of the network resource is completed, reproduction of the title information is resumed” (refer to second paragraph of pg.15 – first paragraph of pg.16, third paragraph of pg.16, of the Amendment filed on 01/30/2009). The system acknowledges the suspension of title information, which in other word means that the system detects the suspension of the title information, hence, the system detects that playing of the essential content is interrupted, and downloads information when the interruption is detected. At least for this

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reason and the 35 USC 112 rejections, Kanazawa discloses every feature that is claimed by the Applicant.

### ***Conclusion***

11. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied up on is considered pertinent to applicant's disclosure.

A Shortened statutory period for reply is set to expire 3 month(s) or thirty (30) days, whichever is longer, from the mailing date of this communication.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Kim whose telephone number is (571) 270-3228. The examiner can normally be reached on Monday - Friday 7:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edward J Kim/  
Examiner, Art Unit 2455

/saleh najjar/  
Supervisory Patent Examiner, Art Unit 2455